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A LIMITED LIABILITY PARTNERSHIP

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Carl K. Smith et al.

Serial No.: 09/763,239

Confirmation No.: 5401

Filed: June 1, 2001

For: SHALE-STABILIZING ADDITIVES

Group Art Unit: 1712

Examiner: Tucker, Philip

Atty. Dkt. No.: 11836.0704.NPUS00

MIDR:704

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**RESPONSE TO NON-FINAL OFFICE ACTION**

Commissioner for Patents  
Washington, D.C. 20231

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I hereby certify that this paper or fee is being deposited with the United States Postal Service "EXPRESS MAIL POST OFFICE TO ADDRESSEE" service under 37 C.F.R. 1.10 on the date indicated above and is addressed to: Commissioner for Patents, Washington D.C. 20231.

*Barbi Sofia*  
Signature

The following is in response to the Office Action dated November 6, 2002:

**AMENDMENTS:**

**TO THE CLAIMS:**

Please cancel claims 1-11 without prejudice

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**REMARKS REGARDING CLAIMS AMENDMENTS:**

Claims 1-11 have been canceled without prejudice for the sole purpose of placing the application in a condition of immediate allowance. Applicants reserve the right to file a continuation/divisional application with the canceled claims.

The claims as amended are submitted as being clearly distinct and patentable over the art of record and therefore their entry and allowance by the Examiner is requested.



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Applicant: Carl K. Smith et al.  
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**IN RESPONSE TO THE OFFICE ACTION:**

REJECTION UNDER 35 USC § 101:

Claim 11 has been rejected under 35 USC § 101 as being directed to non-statutory subject matter. This rejection has been obviated by the Applicant's cancellation of claim 11 without prejudice.

Applicants ask that the Examiner reconsider and withdraw the rejection.

FIRST REJECTION UNDER 35 USC § 112, SECOND PARAGRAPH:

Claims 1-8 were rejected under 35 USC § 112, second paragraph as allegedly being indefinite and failing to particularly point out the Applicant's invention.

Claims 1-8 have been canceled without prejudice in the amendments above.

Applicants submit that the above amendments obviate the rejection of the claims under 35 USC § 112, second paragraph and thus ask that the Examiner reconsider and withdraw the rejection.

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REJECTIONS UNDER 35 USC § 102:

Claims 1-3, and 5-10 have been rejected under 35 USC § 102 as allegedly being anticipated by Derand et al., macromolecules, vol. 29, pages 8770-8775, (1996).

Claims 1-8 have been rejected under 35 USC § 102 as allegedly being anticipated by EP 306449.

Claims 1-8 have been rejected under 35 USC § 102 as allegedly being anticipated by DE 2312616.

Claims 1, 2, 9 and 10 have been rejected under 35 USC § 102 as allegedly being anticipated by U.S. Patent No. 5,739,212 issued to Wutz et al.

Applicants submit that the § 102 rejections have been obviated by the cancellation of claims 1-10 without prejudice and request that the Examiner reconsider and withdraw the rejection.



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The undersigned representative requests any extension of time that may be deemed necessary to further the prosecution of this application.

The undersigned representative authorizes the Commissioner to charge any additional fees under 37 C.F.R. 1.16 or 1.17 that may be required, or credit any overpayment, to Deposit Account No. 01-2508, referencing Order No. 11836.0704.NPUS00.

In order to facilitate the resolution of any issues or questions presented by this paper, the Examiner should directly contact the undersigned by phone to further the discussion.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Carter J. White".

Carter J. White, Ph.D.

Patent Attorney

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Date: 6 Feb 03

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